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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,530	11/24/2003	Helmut Schwartz	P24417	1995
7055	7590	06/02/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			MITCHELL, KATHERINE W	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/718,530

Applicant(s)

SCHWARTZ ET AL.

Examiner

Katherine W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 22-36,38,39,41-46,49 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21,37,40,47 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 1-21,37,40,47-48 in the reply filed on 3/17/2005 is acknowledged. The traversal is on the ground(s) that the search for all species would not be burdensome. This is not found persuasive because specific features require searches in additional subclasses, and the method claims are in a different class.
2. The requirement is still deemed proper and is therefore made FINAL.
3. Claims 22-36, 38-39,41-46, 49-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected embodiment, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/17/2005.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Information Disclosure Statement***

4. The information disclosure statement filed 4/21/2004 includes listings for 3 English abstracts which examiner does not see in the file. However, applicant has done an excellent job of disclosure, and has provided an explanation of relevance in the IDS, so examiner is initialing the foreign patents. Examiner has assumed the problem is in USPTO scanning and imaging systems, and Applicant can provide these abstracts in response to this action, without a resubmission of an IDS and without a fee, and examiner will then initial the English abstracts.

### **Specification**

5. The abstract of the disclosure is objected to because paragraph [0051] discloses sleeve portion B\* of the first connecting part, but no connecting part has been described. Examiner is not sure if connecting part and connecting element are the same. Applicant should review specification and ensure consistent and correct terminology. Correction is required. See MPEP § 608.01(b).

### **Claim Objections**

6. Claims 1-21, 37, 40, and 47-48 are objected to because of the following informalities: applicant has recited the alternatives of the edge and edge segments in an unclear manner. In addition, in claims 15 and 40, the alternatives are also confusingly worded. A Markush Group and its application are discussed in the MPEP Paragraph 2173.05(h).

*Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925).*

*Ex parte Markush sanctions claiming a genus expressed as a group consisting of certain specified materials. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming. See Ex parte Head, 214 USPQ 551 (Bd. App. 1981); In re Gaubert, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975); and In re Harnisch, 631 F.2d 716, 206 USPQ 300 (CCPA 1980). It is improper to use the term "comprising" instead of "consisting of." Ex parte Dotter, 12 USPQ 382 (Bd. App. 1931).*

*The use of Markush claims of diminishing scope should not, in itself, be considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made.*

*Similarly, the double inclusion of an element by members of a Markush group is not, in itself, sufficient basis for objection to or rejection of claims. Rather, the facts in each case must be evaluated to determine*

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*whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite. The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not necessarily render the scope of the claim unclear. For example, the Markush group, "selected from the group consisting of amino, halogen, nitro, chloro and alkyl" should be acceptable even though "halogen" is generic to "chloro."*

*The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. While in the past the test for Markush-type claims was applied as liberally as possible, present practice which holds that claims reciting Markush groups are not generic claims (MPEP § 803) may subject the groups to a more stringent test for propriety of the recited members. Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.*

*When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, then "wherein R is A, B, C or D" shall also be considered proper.*

Appropriate correction is required.

In claim 15, applicant claims "permanently joined" or "non-removably fixed" attachment. Absent any further limitation, any attachment can be removed, although it may be difficult, expensive, or destructive to do so, and thus the claim is considered indefinite.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Radtke USPAP 2002/0009350.

Re claim 1: Radtke teaches a vibration damping ring inert arrangement comprising:

- A vibration dampening ring (6)
- A hollow cylinder (4) with 1<sup>st</sup> and 2<sup>nd</sup> ends and an inner surface connected to the outer surface of the ring
- An outwardly extending edge arranged at the 2<sup>nd</sup> end (flange-like projection 7 or 34 at either respective end in Fig 1.)

Re claim 9: The outwardly extending edge is substantially perpendicular to an axis running through the cylinder.

9. Claims 1 and 9-15 and 17 and 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Roth USP 5397112..

Re claim 1: Roth teaches a vibration damping ring inert arrangement comprising:

- A vibration dampening ring (16)
- A hollow cylinder (12) with 1<sup>st</sup> and 2<sup>nd</sup> ends and an inner surface connected to the outer surface of the ring
- An outwardly extending edge arranged at the 2<sup>nd</sup> end (14, Fig 2.)

Re claim 9: The outwardly extending edge is substantially perpendicular to an axis running through the cylinder.

Re claims 10-12 and 47: Fig 2 shows the vibration-dampening ring having 1<sup>st</sup> and 2<sup>nd</sup> annular projection portions extending beyond the respective ends of the hollow member by an equal given amount.

Re claim 13: Fig 2 shows the 2<sup>nd</sup> end as an annular base surface.

Re claim 14: Col 3 line 67 – col 4 line 6 teaches the vibration dampening ring is rubber.

Re claim 15: Col 2 lines 50-63 disclose that the ring 16 is locked to the inner and outer tubes by static friction. Absent any further limitation, it is considered permanently attached as examiner best understands applicant's claim (see claim objection above).

**However**, if it is held that this teaching is not considered permanent, an alternate rejection is provided below under 103(a) rejections.

Re claim 17: Cylinder 12 is disclosed as metal (steel) in col 3 lines 66-67.

Re claim 48: Roth col 6 lines 47-64 discusses first and second component attachment via the inert.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 15 and 16 and 18 are rejected under 35 U.S.C. 103(a) as obvious over by Roth USP 5397112.

Re claim 15: If it is held that Roth does not teach permanent attachment in his embodiment and the background of the invention, Roth does teach attachment by frictional locking. Col 2 lines 1-9 teach that prior art methods include bonding with a bond agent, but that this was considered by Roth as an expensive alternative. Thus Roth discloses that adhesives or vulcanization are known alternatives to the frictional locking used, which examiner assumes applicant considers permanently joining or non-removably fixing. The fact that Roth chose one alternative does not teach against the other disclosed alternatives. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have joined the vibration ring to the cylinder in a permanent manner, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Re claim 16: Col 2 lines 60-63 teach that the ring 16 is locked "without an adhesive and vulcanization". Col 2 lines 1-9 teach that prior art methods include bonding with a bond agent, but that this was considered by Roth as an expensive alternative. Thus Roth discloses that adhesives or vulcanization are known alternatives to the frictional locking used. The fact that Roth chose one alternative does not teach against the other disclosed alternatives. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Roth before him at the time the invention was made, to select another alternative known means of joining from well-known alternatives based on application needs.



Re claim 18: Roth discloses "steel" as discussed above, but is not specific that it is spring steel. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have selected spring steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, and a resilient mount or bushing with elastomeric core/ring would be expected to need a certain amount of flex as would be provided by spring steel. *In re Leshin*, 125 USPQ 416.

12. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of Bondarowicz et al, USPAP 2002/0009351, hereafter called Bondarowicz.

Re claims 2 and 3: As discussed above, Roth teaches all the elements except a plurality of outwardly extending resilient retaining members. Bondarowicz teaches a cylindrical insert component comprising a plurality of outwardly extending resilient retaining members (30) which serve to secure the hollow cylinder element in a component opening. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Roth and Bondarowicz before him at the time the invention was made, to modify Roth as taught by Bondarowicz to include a plurality of outwardly extending resilient retaining members of Bondarowicz, in order to obtain an insert that could be self-retained and centered in a hole, as the outer sleeve 12 is designed to be secured to a second member in col 6 lines 47-53. One would have been motivated to make such a combination because it would require less time and cost to be inserted into a component, thus improving efficiency.

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13. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radtke in view of Bondarowicz et al, USPAP 2002/0009351, hereafter called Bondarowicz.

Re claims 2 and 3: As discussed above, Radtke teaches all the elements except a plurality of outwardly extending resilient retaining members. Bondarowicz teaches a cylindrical insert component comprising a plurality of outwardly extending resilient retaining members (30) which serve to secure the hollow cylinder element in a component opening. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Radtke and Bondarowicz before him at the time the invention was made, to modify Radtke as taught by Bondarowicz to include a plurality of outwardly extending resilient retaining members of Bondarowicz, in order to obtain an insert that could be self-retained and centered in a hole. One would have been motivated to make such a combination because it would require less time and cost to be inserted into a component, thus improving efficiency.

14. Claims 4-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radtke in view of Hein USP 5261650.

Re claims 4-8: As discussed above, Radtke teaches all the elements except the hollow cylinder having an external circumferential retaining groove with a retaining ring having inwardly extending spring tappets on the retaining ring. Hein teaches a snap-in mount that is frustoconical, not cylindrical, that includes an external circumferential retaining groove (u-shaped recess at 39) with a retaining ring (33) having inwardly extending spring tappets (37,38) on the retaining ring. Therefore, it would have been

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obvious to one of ordinary skill in the art, having the teachings of Radtke and Hein before him at the time the invention was made, to modify Radtke as taught by Hein to include a hollow cylinder having an external circumferential retaining groove with a retaining ring having inwardly extending spring tappets on the retaining ring of Hein, in order to obtain an insert that could be locked securely in place in a hole. One would have been motivated to make such a combination because it would resist movement due to vibrations, and provide more secure attachment in applications where vibrations are expected.

Re claims 10-11: Hein shows the vibration-dampening ring having 1<sup>st</sup> and 2<sup>nd</sup> annular projection portions extending beyond the 2<sup>nd</sup> end of the hollow frustoconical member by a given amount. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Radtke and Hein before him at the time the invention was made, to modify Radtke as taught by Hein to include the vibration-dampening ring having 1<sup>st</sup> and 2<sup>nd</sup> annular projection portions extending beyond the 2<sup>nd</sup> end of the hollow member by a given amount of Hein, in order to obtain an insert that could accept and absorb pressure at the ends without damage, noise, or vibration. One would have been motivated to make such a combination because it would resist movement due to vibrations, and provide more secure attachment in applications where vibrations are expected.

15. Claims 4-8 and 19-21 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of Hein USP 5261650.

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Re claims 4-8 and 40: As discussed above, Roth teaches all the elements except the hollow cylinder having an external circumferential retaining groove with a retaining ring having inwardly extending spring tappets on the retaining ring. Hein teaches a snap-in mount that is frustoconical, not cylindrical, that includes an external circumferential retaining groove (u-shaped recess at 39) with a retaining ring (33) having inwardly extending spring tappets (37,38) on the retaining ring. This ring would obviously elastically compress the hollow cylinder to some degree. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Roth and Hein before him at the time the invention was made, to modify Roth as taught by Hein to include a hollow cylinder having an external circumferential retaining groove with a retaining ring having inwardly extending spring tappets on the retaining ring of Hein, in order to obtain an insert that could be locked securely in place in a hole. One would have been motivated to make such a combination because it would resist movement due to vibrations, and provide more secure attachment in applications where vibrations are expected, including the automotive applications discussed in Roth col 6 lines 47-64.

Re claims 19-21: Hein teaches a snap-in mount that is frustoconical, not cylindrical, with the outer hollow member being considered outer sleeve 17. The outwardly extending edge of 17 is at curved upper end 19, which is shown as having the rubber vibration damping material on it. Col 2 lines 24-28 disclose that the elastomeric/rubber insert is bonded to the outer sleeve 17 and encapsulates the sleeve. Bonding is considered to obviously include adhesive bonding. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Roth and Hein

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before him at the time the invention was made, to modify Roth as taught by Hein to include vibration-damping material bonded to the extending edge of the cylinder, in order to allow vibrational damping in the vertical direction as well as the radial direction. One would have been motivated to make such a combination because it would resist movement due to vibrations, and provide more secure attachment in applications where vibrations are expected, including the automotive applications discussed in Roth col 6 lines 47-64.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell  
Examiner  
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A handwritten signature in black ink, appearing to read "Katherine Mitchell", written in a cursive style.

Kwm  
5/27/2005